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A version marked up to show changes made to the claim relative to the previous version of the claim is attached.

### Remarks

Claims 1-6, 20-23, 26-35, and 40-43 are pending. Claims 7-16, 19, 24, 25, and 36-39 have been canceled. Claim 40 has been amended.

### § 102 Rejections

Claims 1-6, 26-29, and 34-35 stand rejected under 35 USC § 102(e) as being anticipated by Bowers et al (US 5,963,134). MPEP §2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

In regard to claims 1-6, the Office Action states that Bowers et al. discloses an RFID device that comprises an indicator for indicating information regarding one or both a class of materials to which the item 54 belongs, and a desired location for that item. Applicants respectfully disagree for the following reasons.

First, reference number 54 refers to the RFID tag, not the item. Reference number 22 is used to refer to the articles or items with an RFID tag. (See column 8, lines 27-28 and column 9, lines 5-6.)

Second, Bowers et al. does not disclose an RFID device that comprises an indicator for indicating information. Instead, Bowers et al. teaches that a fixed interrogator 43 or a portable RFID scanner 42, which extracts the unique programmed serial number from the RFID tag 54 on the article 22. Then, the serial number is entered into a database record 66 stored on a computer 48 or in a remote computer. (See column 9, lines 41-67 and column 10, lines 1-48.) Then, the user may receive indication of information about the article from the database associated with a computer by a display panel of the monitor connected to the computer maintaining the database. Optionally, the user may receive indication of information about the article from a print out from a printer connected to the computer maintaining the database. (See column 11, lines 63-67 and

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column 12, lines 1-2). Therefore, it is the database, which is separate from the RFID device, which indicates information about the item, not the RFID device itself.

Third, Bowers et al. does not disclose an RFID device that comprises an indicator for indicating information regarding one or both of (i) a class of materials to which the item belongs, and (ii) a desired location for that item. Instead, as mentioned above, the interrogator or scanner extracts the serial number and it is the database 66 associated with the computer that is the indicator of information, not the RFID device. The database indicates the article's Dewey Decimal System call number, a Library of Congress call number, ISBN number or an arbitrarily assigned number and the predetermined location of where the article is currently stored. (See column 10, lines 28-40.) Therefore, contrary to the Office Action's assertion that all elements of claim 1 are disclosed in Bowers et al., element (b) of claim 1 is not; the rejection is unsupported by the art and should be withdrawn.

As a result, claim 1 is not anticipated by Bowers et al. and the rejection should be withdrawn. Claims 2-6, which depend from claim 1 and add further limitations, are likewise not anticipated by Bowers et al. and the rejection should be withdrawn. Applicants therefore requests the rejection of 1-6 under 35 USC § 102(e) of Bowers et al. be withdrawn.

In regard to claims 26-29 and 34-35, the Office Action states that Bowers et al. discloses all of the elements of claims 26-29 and 34-35, specifically relying on Figure 1 and 4, column 9-line 41 through column 10, line 21, column 8, lines 50-56 and column 11, lines 57-65. Applicants respectfully disagree that these sections of Bowers et al. discloses the elements of claim 26. Claim 26 recites:

- (a) providing information to the RFID device identifying a location;
- (b) interrogating the items with the RFID device to determine the identity of the items;  
and
- (c) associating the items with the location.

None of the sections relied upon in the Office Action disclose such a method and thus, the rejection is unsupported by the art and should be withdrawn. Fig. 1 of Bowers et al. is a schematic layout diagram of a library 10. Figure 4 of Bowers et al. is a sample of database records for tagged articles used by the library of Figure 1. Col. 9, line 41 through col. 10, line 21 of Bowers et al. discloses the steps of creating an inventory database, which as mentioned above,

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includes the following steps:

1. a fixed interrogator 43 or a portable RFID scanner 42 extracts the unique programmed serial number from the RFID tag 54 on the article 22;
2. a database record is added for the serial number; and
3. item identification information is obtained for the article and added to the database record for the respective tag serial number.

Col. 8, lines 50-56 of Bowers et al. simply states that the invention is not limited to the particular tag 54 shown and that the IC 62 outputs a data stream comprised of the 64 bits of stored data when sufficient power is applied. Col. 11, lines 57-65 of Bowers et al. discloses that the patron ID device may be incorporated into the interrogator and that to checkout, the patron merely places the ID card and the articles in a defined region and initiates a checkout process. The data output from the interrogator is communicated to the database either directly or via the computer terminal. None of these sections, taken alone or in combination, discloses the method of claim 26, and thus, the rejection is unsupported by the art and should be withdrawn.

As a result, claim 26 is not anticipated by Bowers et al. and the rejection should be withdrawn. Claims 27-29 and 34-36, which depend from claim 26 and add further limitations, are likewise not anticipated by Bowers et al. and the rejection should be withdrawn. Applicants therefore requests the rejection of 26-29 and 34-35 under 35 USC § 102(e) of Bowers et al. be withdrawn.

### **§ 103 Rejections**

Claims 20-23 stand rejected under 35 USC § 103(a) as being unpatentable over Bowers et al. In regard to claims 20-22, the Office Action states that Bowers et al. discloses a method of using an RFID device comprising the steps of determining whether the interrogated item 22 belongs to the location and providing a signal, specifically relying on column 12, lines 3-23 and column 15, line 42 though column 16, line 39, and that it would have been obvious to include the step of inputting information to the device to describe a location. Applicants respectfully disagree for the following reasons.

First, Bowers et al. does not show, teach or suggest the step of determining whether the interrogated item belongs in a location. Column 12, lines 3-23 of Bowers et al. teaches a method of ensuring that only articles which are properly checked out are removed from the library. To

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do this, Bowers et al. teaches that the status of each interrogated article is checked in the database, as the articles pass through the library exit. This "status" is whether or not the article is checked out or not, not the article's location. Column 15, line 42 through column 16, line 39 of Bowers et al. teaches a method of inventory scanning. Specifically, Bowers et al. teaches a method that involves scanning all article holding locations in the library, then comparing the detected serial numbers with the library inventory stored in the database that have not been checked out, so that a missing article report can be generated of all articles which are not located during the scanning process and which have not been checked out. In addition, Bowers et al. teaches a method of identifying mislocated or misshelved articles. However, this method does not include the step of determining whether the interrogated item belongs at the location. Instead, the method compares the call numbers of the articles scanned with the range of call numbers expected to be in the scanned portion 126. Any call numbers outside of the range of call numbers are presumed to be misshelved. It is only the call number that is used in this method taught by Bowers et al., not the location of the article. In fact, neither of these sections of Bowers et al. cited in the Office Action makes mention of the location of the article at all.

Second, with regard to the assertion that it would have been obvious to include the step of inputting information to the device to describe a location, Applicants disagree. Since there is no disclosure, teaching, or suggestion about the article's location, there is no motivation or suggestion to modify Bowers et al. as asserted in the Office Action.

In contrast, the present invention of claim 20 provides: inputting information to the device to describe a location; determining whether the interrogated item belongs at the location; and providing an appropriate signal.

As a result, because the reference does not teach all of the claim's limitations and because there is no motivation or suggestion to modify Bowers et al. as asserted, a prima facie case of obviousness has not been established. (See M.P.E.P. §2143.) Therefore, claim 20 is not rendered obvious by Bowers et al. and the rejection should be withdrawn. Claims 21-22, which depend from claim 20 and add further limitations, are likewise not rendered obvious by Bowers et al. and the rejection should be withdrawn. Applicants therefore requests the rejection of 20-22 under 35 USC § 103(a) of Bowers et al. be withdrawn.

In regard to claim 23, the Office Action states that Bowers et al. discloses a method comprising the steps of detecting the mislocated/misshelved item and providing an indication to

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the user of that location, specifically relying on column 16, lines 1+ of Bowers et al. Applicants respectfully disagree for the following reasons.

First, column 16, lines 1+ of Bowers et al. teaches a method of identifying mislocated or misshelved articles that does not involve the step of detecting where within the group of items a desired item should be placed and then providing an indication to the user of that location. Instead, as mentioned above, the Bowers et al. method compares the call numbers of the articles scanned with the range of call numbers expected to be in the scanned portion 126. Any call numbers outside of the range of call numbers are presumed to be misshelved. Bowers et al. teaches that a portable computer 122 may signal the employee to locate and properly shelve the misshelved article 22. There is no suggestion or teaching of providing the user an indication of that location where the article properly belong.

Second, with regard to the assertion that it would have been obvious to include the step of detecting where within the group of items a desired item should be placed, Applicants disagree. Since there is no disclosure, teaching, or suggestion about the article's location of where the article properly belongs, there is no motivation or suggestion to modify Bowers et al. as asserted in the Office Action.

As a result, because the reference does not teach all of the claim's limitations and because there is no motivation or suggestion to modify Bowers et al. as asserted, a prima facie case of obviousness has not been established. (See M.P.E.P. §2143.) Therefore, claim 23 is not rendered obvious by Bowers et al. and the rejection should be withdrawn.

Claims 30 and 32-33 stand rejected under 35 USC § 103(a) as being unpatentable over Bowers et al. in view of Frich (U.S. Pat. No. 6,074,156). Claims 30 and 32-33 depend from claim 26. Claim 26 is allowable for at least the reasons given above. Therefore, claims 30 and 32-33, which depend from claim 26 and add further limitations, are likewise allowable and the rejection should be withdrawn.

Claim 31 stands rejected under 35 USC § 103(a) as being unpatentable over Bowers et al as modified by Frich as applied to claim 26 above, and further in view of Ghaffari et al (U.S. Pat. No. 5,708,423). Claim 31 depends from claim 26. Claim 26 is allowable for at least the reasons given above. Therefore, claim 31, which depends from claim 26 and add further limitations, are likewise allowable and the rejection should be withdrawn.

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Claims 40 and 41 stand rejected under 35 USC § 103(a) as being unpatentable over Sone (US 2002/0,035,560 A1) in view of Cannon et al (EP 0,794,507 A2). Applicants respectfully disagree for the following reasons.

First, MPEP §2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Office Action recognizes that Sone fails to teach or suggest a system which provides an indication of the location of the item of interest. In addition, Applicants point out that Sone does not show, teach, or suggest the desirability of such a feature. Instead, Sone teaches an adaptively reconfigurable electronic information display (paragraph 0001) to display in a shopping display system item pricing indicators and other identifying information such as size, weight, unit price in a language, form, and format which is directed to the specific needs of a particular customer (paragraph 0008) upon the interrogator associated with the specific display (paragraph 0032) interacting with the customers ID card (paragraphs 0012 and 0032). Each display presents information pertinent to the particular goods in proximity to the display panel (paragraph 0031). Sone teaches that its embodiment is helping the customer avoid purchasing an undesired item or desired item in an undesired quantity because of the large numbers of non-national language speaking people having to interact with local retail stores. (paragraph 006)

Second, even if Sone and Cannon et al. were somehow combined, the combination does not show, teach or suggest all of the limitations of claim 40. Cannon et al. does not show, teach, or suggest providing a step of interrogating the RFID card, where the RFID element on the card has the information stored related to an item of interest, and then providing an indication of the location of the item of interest relative to the location of the RFID card reader. Instead, Cannon et al. teaches that it is the electronic tag itself attached to the item of interest which provides an indication of its location by generating an active response, specifically by emitting a sound, or based on the active response from the electronic tag, the interrogator provides an indication of the tag's location. (See column 3, lines 2-20.) Claim 40 has been amended to more clearly recite that the information transmitted and stored in the RFID element relates to an item of interest. Support for such amendment may be found throughout the application, for example on page 29, lines 32-33 and page 30, lines 1-30.

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As a result, because there is no motivation or suggestion to modify Sone as asserted and because the combination of references do not teach all of the limitations of claim 40 and, a prima facie case of obviousness has not been established. (See M.P.E.P. §2143.) Therefore, claim 40 is not rendered obvious by the combination of Sone and Cannon et al. and the rejection should be withdrawn. Claim 41, which depends from claim 40 and adds further limitations, is likewise allowable and the rejection should be withdrawn.

Claim 42 stands rejected under 35 USC § 103(a) as being unpatentable over Sone as modified by Cannon et al as applied to claim 40, and further in view of Marsh et al (EP 0,494,114). Claim 42 depends from claim 40. Claim 40 is allowable for at least the reasons given above. Therefore, claim 42, which depends from claim 40 and add further limitations, are likewise allowable and the rejection should be withdrawn.

Claim 43 stands rejected under 35 USC § 103(a) as being unpatentable over Sone as modified by Cannon et al as applied to claim 40, and further in view of Bowers et al. Claim 43 depends from claim 40. Claim 40 is allowable for at least the reasons given above. Therefore, claim 43, which depends from claim 40 and add further limitations, are likewise allowable and the rejection should be withdrawn.

Withdrawal of the outstanding rejections and allowance of the pending claims is respectfully requested. If a telephonic conference would be helpful in resolving any outstanding matters in the present application, the Examiner is encouraged to contact Applicants' undersigned representative.

Respectfully submitted,

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**Version with markings to show amendments made:****In the Specification:**

On page 4, starting on line 5 and ending on line 13:

From the foregoing discussion, it should be clear that there are a number of applications for RFID tags in various environments in which the identity of the tagged item is important. For example, PCT Publication WO 99/05660, published February 4, 1999 and assigned to Checkpoint Systems, Inc., describes an inventory system using articles with RFID tags. The preferred embodiment described therein contemplates the use of RFID tags in library materials, which may then be checked out automatically by interrogating the RFID tag to determine the identity [identify] of the material. However, a number of important or desirable library or other inventory functions remain that are not described or suggested in the '660 publication.

**In the Claims:**

40. (Amended) A method of locating an item of interest associated with an RFID element among a larger group of items each associated with an RFID element, comprising the steps of:

- (a) providing a card having an RFID element;
- (b) transmitting information related to an item of interest to the card and storing that information in the RFID element;
- (c) positioning RFID card readers at positions near the item of interest;
- (d) interrogating the RFID card with the RFID card reader; and
- (e) providing an indication of the location of the item of interest relative to the location of the RFID card reader.